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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/516,324

02/15/2005

Thorsten Scheibel

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EXAMINER

LAZORCIK, JASON L

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

10/14/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/516,324</p>	<p>Applicant(s) SCHEIBEL ET AL.</p>	
	<p>Examiner JASON L. LAZORCIK</p>	<p>Art Unit 1791</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 September 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 14-28.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Steven P. Griffin/
Supervisory Patent Examiner, Art Unit 1791

Continuation of 3. NOTE:

Applicants amendment to claims 14,16,17,18,19,23, and 28 comprise a change in terminology from a step of "stabilizing and/or compressing" to a step of "stabilizing and/or consolidating". Applicant alleges that the amendment represents a better translation of the original German term "verdichtet". It is the Examiners position that the terms consolidating and compressing connote distinct processes and that the alleged process of consolidating is not supported in the English language Specification as originally filed. Absent a certified English language translation suggesting otherwise, Applicants proposed claim amendments are deemed to represent new matter as defined under 35 U.S.C. 112, first paragraph .

Continuation of 11. does NOT place the application in condition for allowance because:

Applicants arguments presented in the request for reconsideration have been considered but are not deemed to be persuasive for the following reasons:

1) With respect to the rejection of claims under 35 U.S.C. 102(b) over Caligostro, Applicant argues that Caligostro does not disclose a step of coating the stabilized body with a carbon-containing solution. Rather, Applicant argues that Caligostro "involves only material deposition from the gaseous phase".

On this matter, the Examiner disagrees.

Specifically, it is the Examiners position that the base body is both stabilized and and coated with a carbon containing solution, namely trichloromethylsilane (see fig.1, and col. 4, lines 61-68). To the extent that Applicant appears to argue that Caligostro does not directly apply a liquid to the surface to the base body, Applicant is advised that such a limitation is not recited in the claim language. It follows, in response to applicant's argument that the references fail to show certain features of applicant's invention, that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

2) With respect to the rejection of claims under 35 U.S.C. 103(a) over Brickerdike and Morz, Applicant argues that Merz has nothing in common with the Brickerdike reference "except for an initial step of carbonization". Applicant concludes that one of ordinary skill in the art would find "absolutely no motivation to change the process of Brickerdike" by the Morz disclosure.

Again, the Examiner disagrees with Applicants allegations.

Specifically, factors which would lead one of ordinary skill in the art to combine the Brickerdike and Morz references were clearly presented in the Official Action dated May 20, 2008 (see specifically page 7). Specifically, Bickerdike teaches the preparation of a reinforced base body of carbon while Morz teaches that the honeycomb shape, aramid paper starting materials, and siliconization steps are all known in the art. Applicant was further advised that subjecting a carbon body to siliconization process represents a known and obvious approach for rendering carbonized base body suitable application in high temperature environments. Applicant has failed to provide a convincing rebuttal to the Examiners position on this matter. The mere fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).